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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/658,672	09/08/2000	Takekazu Kumagai	B588-012	3660

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EXAMINER

PATEL, JAGDISH

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 08/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/658,672

Applicant(s)

KUMAGAI, TAKEKAZU

Examiner

JAGDISH PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5,8,9,11-14 and 17-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5,8,11,12 and 17-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) 9 and 13-14 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This communication is in response to amendment filed 5/12/05.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/3/05 has been entered.

Response to Amendment

3. Claims 5, 8, 11, 12 and 17 have been amended and new claims 18-22 have been added. Claims 15-16 have been canceled. Claims 5, 8, 9, 11-14 and 17-22 are currently pending of which claims 9 and 13-14 have been withdrawn from consideration and claims 5, 8, 11, 12 and 17-22 are subject of this office action.

Response to Arguments

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4. Applicant's arguments with respect to claims 5-6, 8 and 11-12 concerning rejection under 35 USC §103(a) have been considered but are moot in view of the new ground(s) of rejections.

Applicant's amendment resulted in withdrawal of the claim rejection under 35 USC §112 (second paragraph) cited in the prior office action.

Priority

4. Acknowledgment is made of applicant's claim for foreign priority under 35

U.S.C. 119(a)-(d). The certified copy has been filed in the instant application on

11/22/2000. ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 12, 20 and 22 are rejected under 35 USC § 101 because the claimed inventions are directed to non-statutory subject matter. Claims 12, 20 and 22 are directed to disembodied data structure which are per se are not statutory (*In re Warmerdam*, No. 93-1294 (Fed. Cir. August 11, 1994)). The examiner suggests to redraft the claims to include a computer-readable medium so that the claimed software in combination with a computer-readable medium will be capable of producing a useful, concrete and tangible result. A claim to a computer-readable medium encoded with functional descriptive material that can function with a computer to effect a practical application that results in a useful, concrete and tangible result (i.e. executing a stock transaction or generating an investment portfolio) satisfies section 101. See U.S. Patent 5,710,578 to Beauregard et al.

For example claim 12 recites a storage medium which stores a program which by itself can not execute the process recited until it associated with a server or a computer which is capable of executing the process steps recited.

This analysis also applies to claim 22.

Claim 20 recites a server which comprises a set of instructions (which are not recited as means for structure to conform to 112(sixth)) interpreted as computer software program instructions or codes. Unless these means are acted upon by a processor, the recited server would not produce an useful, concrete and tangible result.

Claim Rejections - 35 USC § 112

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6. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 17 recites the limitation "the processing for the file data" . There is insufficient antecedent basis for this limitation in the claim. This limitation is interpreted as "process executed on the stored file data."

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 20-22 are rejected under 35 U.S.C. 102(e) as being clearly by Arai.

Per claim 20, Arai teaches a accounting server connected to a network comprising:

reception means for receiving the managed usage information from a storing terminal;

(refer to billing processing unit 105);

Price management means for managing price information of process executed on the file data (refer to col. 8 L 42+ "billing an amount of money corresponding to the practical content of the use..");

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Calculating means for calculating usage fee of the plurality of each of the plurality of storage areas in which the file data is stored on the basis of the received usage information and the managed price information (refer to col. 8 L 42+ “billing an amount of money corresponding to the practical content of the use..”).

Claims 21 and 22 recite a method and apparatus corresponding to claim 20 and are rejected on the same grounds of rejection.

Claim Rejections - 35 USC § 103

10. Claims 5, 11, 12 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsumura (US Pat. 5,842,023) and further in view of Arai (US Pat. 6,714,920) (Foreign Priority: Japan Sept. 5, 1997).

11. Per claim 5 Tsumura recites a storage apparatus connected to a network, comprising:
storage means for storing file data in each of a plurality of storage areas (see Figures 2-4);

management means for managing usage information related to a process executed on the stored file data, corresponding to each of the plurality of storage areas in which the file data is stored;

(refer to col. 15 L 65- col. 16 L 13, refer to charging information 55 and copyright manager, “..fee is charged ..for one movie or one set of information..”, “..a fee can be charged, such as a fee for copying only the theme music for a specific scene in a movie, or a fee for printing a table or a diagram on a specific page in a document.”)

Tsumura, fails to teach transmitting means for transmitting the managed usage information to an accounting server. Arai, in the same field of endeavor teaches a storage

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apparatus which comprises transmitting means for transmitting the managed usage information to an accounting server (refer to Arai, Figure 3 (communication net work interface unit 209 which is connected to communication network 4 which transmits usage data to the billing unit 105, refer also to col. 8 L 43-60).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated a transmitting means for transmitting the managed usage information to an accounting server in the apparatus of Tsumura in view of Arai because this improvement would allow retrieval and billing on a individual content usage basis, would allow different charging methods and provide for billing on the basis of different processes executed on the stored information (see col. 16 L 1-12 of Tsumura and col. 8 L 42+ of Arai)

Claims 11 and 12: correspond to the apparatus claim 5 which respectively performs the method steps recited.

Claim 17: processing for the file data is at least printing, polling transmission and forwarding (refer to Tsumura col. 16 L 2+, the features recited are explicitly or implicitly shown).

Claim 18: wherein said accounting server calculates usage fee of each of the plurality of storage areas in which the file data is stored (see citation of Tsumura and Ari). See also motivation for the combination of the two references.

Claim 19: Tsumura teaches an accounting system comprising a storing terminal comprising the elements as analyzed per claim 5.

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Arai teaches a accounting server connected to a network comprising reception means for receiving the managed usage information from a storing terminal; (refer to billing processing unit 105);

Price management means for managing price information of process executed on the file data (refer to col. 8 L 42+ “billing an amount of money corresponding to the practical content of the use..”);

Calculating means for calculating usage fee of the plurality of each of the plurality of storage areas in which the file data is stored on the basis of the received usage information and the managed price information (refer to col. 8 L 42+ “billing an amount of money corresponding to the practical content of the use..”).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated a transmitting means for transmitting the managed usage information to an accounting server in the apparatus of Tsumura in view of Arai because this improvement would allow retrieval and billing on a individual content usage basis, would allow different charging methods and provide for billing on the basis of different processes executed on the stored information (see col. 16 L 1-12 of Tsumura and col. 8 L 42+ of Arai).

12. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tsumura and Arai as applied to claim 5 and further in view of Dedrick ('509 Patent).

Claim 8. Tsumura and Arai fail to teach, however, Dedrick teaches a password setting means for setting a password for authorizing the process to the file data stored in each of the plurality of storage areas. (col. 3 L 17-21 Each client computer 12 is provided with a graphic

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user interface (GUI) that allows the end user to participate in the system 10. The GUI will contain fields that

It would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated password setting means as per claim 8 because this would provide protection against unauthorized users.

Conclusion

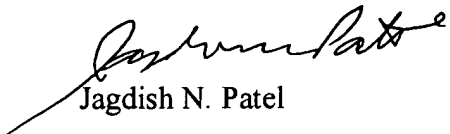
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748. The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 517-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3624)

8/29/05